

## **REMARKS**

Claims 256-292 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

Claims 256-292 were rejected under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent No. 6,661,356 as set forth in the Office Action.

While not conceding the propriety of the rejection, Applicant submits that the rejection is improper since a terminal disclaimer was filed at the time of filing of this Application. A copy of the terminal disclaimer (**Exhibit A**) and post card (**Exhibit B**) (which identifies the terminal disclaimer and was stamped received by the USPTO) are being submitted herewith.

Since the double patenting rejection is the sole outstanding rejection, Applicant believes that the case is in condition for allowance.

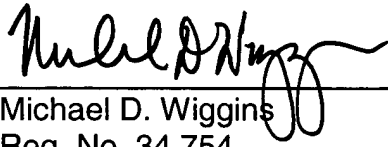
## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the

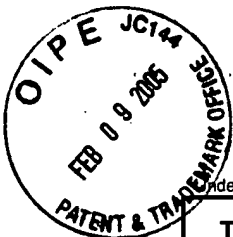
Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 2/10/05

By:   
Michael D. Wiggins  
Reg. No. 34,754

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600



**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE  
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

Docket Number (Optional)  
MP0085.C1

In re Application of: Oberg, Mats

Application No. Unassigned

Filed: Herewith

For: Method And Apparatus For DC-Level Constrained Coding

The owner\*, Marvell Semiconductor, Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/053,885, filed on January 16, 2002. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

Signature

10/28/03

Date

Michael D. Wiggins

Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**


\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



Applicant: Oberg, Mats	Case No.: MP0085C1
Serial No.: To Be Assigned	Filing Date: Herewith
Title: METHOD AND APPARATUS FOR DC-LEVEL CONSTRAINED CODING	

Please acknowledge receipt of:  
Submission of Credit Card Payment for \$1168; Utility Patent  
Application Transmittal with Express Mail Label No.  
EL741126353US; Fee Transmittal (in duplicate); Application  
Data Sheet; 70 Page Patent Application; 9 Sheets of Formal  
Drawings; Declaration and Power of Attorney; Information  
Disclosure Statement; PTO Form 1449; Preliminary Amendment;  
Nonpublication Request Under 35 U.S.C. 122(b)(2)(B)(i);  
Terminal Disclaimer; Associate Power of Attorney; and Return  
Postcard.

22141 U.S. PTO  
10/695531  
  
102803

By stamping and returning to Harness, Dickey & Pierce, P.L.C.  
Due: Attorney: Eric B. Janofsky

USPTO Date Stamp